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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,501	08/05/2003	Uri Armin	1335VAS-US	5179
7590 Dekel Patent Ltd. Beit HaRofim Room 27 18 Menuha VeNahala Street Rehovot, ISRAEL		05/01/2007	EXAMINER HOFFMAN, MARY C	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/633,501	ARNIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Mary Hoffman	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 February 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4,6 and 22-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4,6,22-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Garber (U.S. Patent No. 5,725,587).

Garber discloses an elastomeric cover (col. 1, lines 8-20) having a seamless articulating surface which is at least part of a three-dimensional curved surface, wherein a cross-section of a portion of said seamless articulating surface is an arc that subtends an angle greater than 180 degrees (FIG. 2). The seamless articulating surface comprises a portion of a sphere greater than a hemisphere. The cover comprises a seam on the non-articulating surface. The non-articulating surface comprises an inner surface adapted to contact an outer surface of a rigid implant. The non-articulating surface comprises an inner surface of said elastomeric cover adapted to contact an outer surface of rigid part of an orthopedic implant. The terminology "mold-parting seam" and that the elastomeric cover is produced by "at least one of injection molding and blow molding" is being considered as product by process claims. In a product by process claim, if the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts

to the applicant to provide evidence to the contrary. The elastomeric cover has a smooth surface (FIG. 7). The elastomeric cover has a non-smooth surface (porous, col. 7, lines 23-26).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5,725,587).

Garber discloses the claimed invention except for a thickness in a range of about 1 mm to about 4 mm, a material hardness in a range of about 60 Shore A to about 95 Shore A, and an elastic modulus in a range of about 10 to about 150 MPa. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Garber having a range of about 1 mm to about 4 mm, a material hardness in a range of about 60 Shore A to about 95 Shore A, and an elastic modulus in a range of about 10 to about 150 MPa, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5,725,587) in view of Dunlap et al. (U.S. Patent No. 5,167,968).

Garber discloses the claimed invention except for the cover having removable extraneous material extending away from the articulating surface.

Dunlap et al. disclose that removable extraneous material extending away from the articulating surface, or excess material, is typically left behind in blow molding applications, and in order to finish the blow mold, the excess material needs to be removed (col. 1).

It would have been obvious that the device of Garber et al. have removable extraneous material extending away from the articulating surface in view of Dunlap et al. because it is well known in the art of blow molding that extraneous material remains after something is molded and the extraneous portion needs to be removed this in order to finish the blow mold.

If Applicant argues that the device of Garber is not seamless although the seam is not shown in the diagrams, then claims 1, 4 and 22-25 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5,725,587) in view of Schuessler (U.S. Patent Applicant Publication 2003/0018387).

Garber discloses an elastomeric cover (col. 1, lines 8-20) having an articulating surface which is at least part of a three-dimensional curved surface, wherein a cross-section of a portion of said seamless articulating surface is an arc that subtends an angle greater than 180 degrees (FIG. 2). The articulating surface comprises a portion of a sphere greater than a hemisphere. The cover comprises a seam on the non-articulating surface. The non-articulating surface comprises an inner surface adapted to

contact an outer surface of a rigid implant. The non-articulating surface comprises an inner surface of said elastomeric cover adapted to contact an outer surface of rigid part of an orthopedic implant. Claim 3 discloses a "mold-parting seam" and claim 10 discloses that the elastomeric cover is produced by at least one of injection molding and blow molding, and these are being considered as product by process claims. In a product by process claim, if the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary. The elastomeric cover has a smooth surface (FIG. 7). The elastomeric cover has a non-smooth surface (porous, col. 7, lines 23-26).

Garber discloses the claimed invention except for the articulating surface being seamless and the cover having a thickness in a range of about 1 mm to about 4 mm, a material hardness in a range of about 60 Shore A to about 95 Shore A, and an elastic modulus in a range of about 10 to about 150 MPa.

Schuessler discloses a system for molding shells of medical implants to eliminate undesirable seams (paragraph [0014]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made construct the device of Garber using the system of Schuessler in order to eliminate undesirable seams. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Garber in view of Schuessler having a range of about 1 mm to about 4 mm, a material hardness in a range of about 60 Shore A to about 95 Shore A, and an elastic

modulus in a range of about 10 to about 150 MPa, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5,725,587) in view of Schuessler (U.S. Patent Applicant Publication 2003/0018387) and further in view of Dunlap et al. (U.S. Patent No. 5,167,968).

Garber in view of Schuessler discloses the claimed invention except for the cover having removable extraneous material extending away from the articulating surface.

Dunlap et al. disclose that removable extraneous material extending away from the articulating surface, or excess material, is typically left behind in blow molding applications, and in order to finish the blow mold, the excess material needs to be removed (col. 1).

It would have been obvious that the device of Garber et al. in view of Schuessler have removable extraneous material extending away from the articulating surface in view of Dunlap et al. because it is well known in the art of blow molding that extraneous material remains after something is molded and the extraneous portion needs to be removed this in order to finish the blow mold.

#### ***Response to Arguments***

Applicant's arguments filed 02/20/2007 have been fully considered but they are not persuasive.

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Applicant argues that the prior art does not show an elastomeric covering which is invertible, i.e. capable of being inverted. The examiner respectfully disagrees, since one of the definitions of "invert" is "to turn upside down" (see Dictionary.com). The prior art is clearly capable of being turned upside down, for example, by simply rotating the structure by 180 degrees.

The rejections are deemed proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

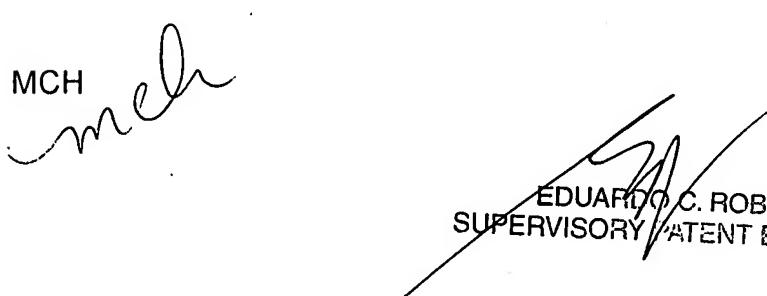
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER